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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/485,071 02/03/00 REICH

N 30794.30USWD

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HM12/0917

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EXAMINER

WILSON, J

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

09/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/485,071

Applicant(s)

Reich et al.

Examiner

James O. Wilson

Group Art Unit

1623

☒ Responsive to communication(s) filed on Aug 23, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) 16-25 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Applicant's election with traverse of Group I, claims 1-10 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the examiner has not asserted the inventions are independent and the search would not be burdensome. This is not found persuasive because despite applicant's arguments, the MPEP is clear that there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(I)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(I), § 808.01(a), and § 808.02).

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 2-9 are seen to be substantial duplicates of the claim from which they all ultimately depend, which is claim 1. Please note the examiner considers asserted modulatory activity, source of enzymes to be affected by the compound claimed, and the inhibition constant are not seen to be further limitations to the structural core or the tangible chemical identity of the product applicants intend to claim. Recitation of the intended utility into the claim language is not considered a further limitation of the claim. Therefore, claims 2-9 fail to further limit claim 1 and are seen to be duplicate claims. In claim 10, the reference to Figure 1B should be deleted. The inclusion of the reference to Figure 1B renders the claim in which it depends indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Froehler et al patent 5,830,653.

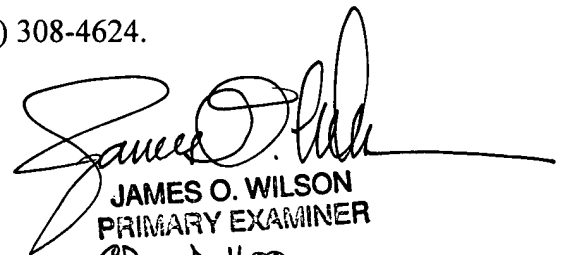
Claims 1-9 are drawn to a composition of matter, which is an oligonucleotide comprised of a C-5 methylcytosine. It is noted that there is an asserted "intended use" of the final product, which is not seen to add to the patentability of the final product. The courts have decided that the inclusion of an intended utility (i.e. recognizing and binding an allosteric site on DNA cytosine methyltransferase.....), where in the composition of matter claim can otherwise stand alone, is not considered a further limitation of the claim. In the instant case, the claims are seen to be drawn to

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a composition of matter, and the expected activity, utility or subsequent use is not seen to constitute a further limitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Froehler discloses synthetic oligonucleotides comprised of C-5-methylcytosine. Applicant's attention is directed to Sequence ID Nos. 1, 2, 3, 7, 8, 9, 14, 15, 23, 25, 28, 29, 30, 31, 32, 33, 35, 36, 43, 44, 45, 50, 51, all of which are seen to be synthetic oligonucleotides which contain C-5-methylcytosine. The disclosure of these oligonucleotide sequences is seen to anticipate claims 1-9.

Any inquiry concerning this communication should be directed to James O. Wilson, Primary Examiner in Art Unit 1623 at telephone number (703) 308-4624.



JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600